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In re Patent of Chen et al.	:	
Patent No. 7,555,206	:	DECISION ON REQUEST
Issue Date: June 30, 2009	:	FOR RECONSIDERATION OF
Application No. 10/840,225	:	PATENT TERM ADJUSTMENT
Filing Date: May 7, 2004	:	
Attorney Docket No. 320528294US	:	

This is in response to the "Application for Patent Term Adjustment Reconsideration Under 37 C.F.R. § 1.705(B)" filed August 31, 2009, which is being treated as a request under 37 C.F.R. § 1.705(d).<sup>1</sup> Patentees request the determination of patent term adjustment indicated on the issue notification (and on the patent) be corrected from seven hundred fifteen (715) days to one thousand eighteen (1,018) days.

The request for reconsideration of the patent term adjustment indicated on the patent is **dismissed**.

The application matured into United States Patent No. 7,555,206, with a patent term adjustment of 715 days on June 30, 2009. This request for reconsideration was timely filed on Monday, August 31, 2009.

Patentees assert the correct patent term adjustment is 1,018 days. Specifically, patentees assert:

The PTO properly accounted for the delay under 35 U.S.C. § 154(b)(1)(A), referred to as "A delay." The A delay is 775 days.

The PTO failed to properly account for the delay under 35 U.S.C. § 154(b)(1)(B), referred to as "B delay." The B delay is 409 days.

The PTO failed to properly account for the overlap under 35 U.S.C. § 154(b)(2)(A) in the A delay and B delay. The overlap is 106 days....

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<sup>1</sup> Patentees do not dispute the patent term adjustment indicated in the Notice of Allowance. Instead, patentees assert the patent should have indicated a revised patent term adjustment as a result of delay in the issuance of the patent. Therefore, the paper filed August 31, 2009, is properly treated as a request filed under 37 C.F.R. § 1.705(d).

The correct patent term adjustment is the sum of the A delay and the B delay minus the overlap and minus the reduction [for Applicant delay]. Thus, the correct patent term adjustment is  $775 + 409 - 106 - 60$ , which is 1,018 days.

The first issue to be addressed is patentee's assertion the correct number of days of B delay is 409 days.

Per 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include "any time consumed by continued examination of the application requested by the applicant under section 132(b)."<sup>2</sup> In other words, B Delay in this case does not include the time period from the date a request for continued examination was filed until the date the patent issued.

The application was filed May 7, 2004. A Request for Continued Examination was filed June 19, 2008. The number of days beginning on the day after the date three years after the application was filed until the *day before* the date a RCE was filed is 408 days. Therefore, the amount of B delay in the instant case is 408 days.<sup>3</sup>

The second issue to be addressed is the extent, if any, to which the patent term adjustment listed on the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) should have been increased as a result of B delay.

35 U.S.C. § 154(b)(2)(A) limits Office delay to the sum of A delay and B delay to the extent such periods of delay are not overlapping. Patentees assert the period of overlap is 106 days. The Office does not agree with patentees' assertion. The Office contends the period of overlap is 408 days.

The Office has described its position regarding the proper interpretation of 35 U.S.C. § 154(b)(2)(A) as follows:

If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years

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<sup>2</sup> See *Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56,366, 53,370-53,371 (September 18, 2000):

35 U.S.C. 154(b)(1)(B) provides that an applicant may receive a term adjustment if the application is not issued within three years of the filing date of the application, excluding (among other things) any time consumed by continued examination requested under 35 U.S.C. 132(b). Once a request for continued examination under 35 U.S.C. 132(b) and § 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and § 1.114.

<sup>3</sup> The instant case does not contain any time periods falling under 35 U.S.C. §§ 154(b)(1)(B)(ii)-(iii).

after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment.<sup>4</sup>

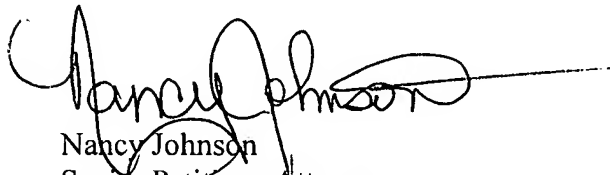
In this case, the relevant time period when determining if periods of delay “overlap” is the time period from the filing date of the application, May 7, 2004, to the date of issuance of the patent, June 30, 2009, excluding the time period consumed by continued examination of the application under 35 U.S.C. § 132(b). In other words, the relevant time period for determining if periods of delay “overlap” is May 7, 2004, to June 18, 2008.

The 408 days of B delay overlap with 408 of the 755 days of A delay accrued prior to the filing of the request for continued examination. Therefore, the Office acted properly when the Office did not enter any additional days to the patent term adjustment for B Delay when issuing the patent.

In view of the previous discussion, the patent term adjustment set forth on the patent remains 653 days which is the sum of A delay (755 days) and B delay (408 days) reduced by the overlap between A delay and B delay (408 days) and reduced by 60 days of Applicant delay.

Submission of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.



Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

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<sup>4</sup> *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004) (quoting *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704, 21706 (April 22, 2004)). The Notice also provided a discussion of an example of the application of the overlap provision:

A two month delay in issuing a first Office action (35 U.S.C. 154(b)(1)(A)(i)) and a two-month delay in issuing the patent (35 U.S.C. 154(b)(1)(B)) [are] considered overlapping delays, even though the two-month delay in issuing the first Office action occurred prior to three years (thirty-six months) after the application's filing date. This is because if the Office does not issue the patent until three years and two months (thirty-eight months) after its filing date, the relevant period in determining the Office delay in issuing the patent is not just the period between three years (thirty-six months) after the application's filing date and the date the patent issues (thirty-eight months after the application's filing date), but is the entire period between the application's filing date and the date the application issues.